

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of.: Schacht, D.W. *et al.*
Serial No.: **10/623,864**
Filed: July 22, 2003
Title: **TRANSDERMAL DELIVERY SYSTEM FOR THE
ADMINISTRATION OF ROTIGOTINE**
Group Art Unit: 1611
Examiner: C.E. Rae
Confirmation No.: 6414
Docket No.: **6102-000069/US**
Client Ref.: P/Wo/VII/10/02

SUBMITTED ELECTRONICALLY VIA EFS-WEB

June 24, 2008

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

SUPPLEMENTARY RESPONSE TO OFFICE ACTION DATED AUGUST 17, 2007

This paper supplements Applicant's response dated February 15, 2008 to the non-final Office Action dated August 17, 2007 in the above referenced application. Applicant received an Office communication dated May 28, 2008 (a) stating that Applicant's February 15, 2008 submission failed to affirmatively respond to a provisional double patenting rejection in the August 17, 2007 Office Action, and (b) setting a one-month period for correction of this alleged deficiency.

The undersigned appreciates the courtesy of the Examiner in clarifying this matter by telephone on June 10, 2008.

No fee is believed due in respect of this submission, which is timely made. If any fee should be payable, authorization is provided herewith to charge such fee to Deposit Account No. No. 08-0750.

Section 4 of Applicant's response dated February 15, 2008 is hereby replaced as set

forth below, without admission that said section, in which a provisional response was made to a provisional rejection, was improperly non-responsive.

4. Provisional double patenting rejection

4.1. Double patenting over Serial No. 10/429,283 in view of Brecht

Claims 1–6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over presently withdrawn Claims 5–16 of copending application Serial No. 10/429,283, in view of Brecht (U.S. Patent Application Publication No. 2001/0053777). The rejection is provisional because the allegedly conflicting claims have not yet been patented.

The present rejection is respectfully traversed, at least for the following reason. Each of Claims 1–6 of the present application requires that the TDS matrix comprise a multitude of rotigotine-containing microreservoirs having a maximum diameter that is less than the thickness of the matrix. This limitation of Claims 1–6 is not taught or suggested by the reference claims, nor is any disclosure found in Brecht that would correct this deficiency. At least Claims 2, 5 and 6 of the present application recite additional limitations that are not taught or suggested by any combination of the reference claims and Brecht.

No reasoning is provided in the Action to support the Examiner's assertion that "the instant claims are either anticipated by, or would have been obvious in view of the referenced claims." Applicant submits that at least the distinguishing features mentioned above are sufficient to create patentable distinction over Claims 5–16 of the '283 application in view of Brecht.

4.2. Double patenting over Serial No. 10/627,990 in view of Brecht

Claims 1–6 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1–13 of copending application Serial No. 10/627,990, in view of Brecht. The rejection is provisional because the allegedly conflicting claims have not yet been patented.

The present rejection is respectfully traversed, at least for the reason that the present application has an earlier filing date (July 22, 2003) than the reference application (July 28, 2003), and therefore, when issued as a patent, will expire before any patent that issues from

Serial No. 10/623,864

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Supplementary Response to Office Action dated August 17, 2007

June 24, 2008

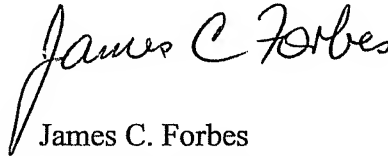
the reference application. Rejection for double patenting is warranted only where "issuance of a second patent would provide unjustified extension of the term of the right to exclude granted by a patent" (MPEP §804.II.B.1). That is not the case here.

Applicant notes that a pending Office Action in the '990 application includes a double patenting rejection over claims of the present application.

Withdrawal of the present double patenting rejections is respectfully requested.

Respectfully submitted,

HARNESS, DICKY & PIERCE, P.L.C.

A handwritten signature in cursive script that reads "James C. Forbes". The signature is written in black ink and is positioned above the printed name and title.

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